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Grover Mundell

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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/710,813

Applicant(s)

MUNDELL ET AL.

Examiner

Cheyne D. Ly

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 12 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-24 are examined on the merits.

### **OBJECTIONS**

2. Claim 12, line 3, recites the phrase "advanced past" wherein the term "past" has been interpreted as a typographical error. Examiner is interpreting the phrase to recite "advanced passed." Appropriate correction is required.
3. Claim 22 is objected to because of the following informalities: Line 3 recites "leas tone", which has been interpreted as "at least one". Appropriate correction is required.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "the association tool" in line 6. There is insufficient antecedent basis for this limitation in the claim. Claims 2-14 are rejected for being dependent from claim 1.
7. Claim 12, line 3, recites "advanced past the association" which causes said claim to be vague and definite because the metes and bounds of the claim has not been specifically defined. Claim 12 is not clear as to what of the transcript is advanced passed the association.

### **CLAIM REJECTIONS - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 13-16, 19-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Robins (US 5392428 A).

### **CLAIM INTERPRETATIONS**

10. Robins discloses Digest Records File typically contains one or more records for each transcript (column 7, line 55, to column 8, line 53). The files in the relational database provide for associating other information with the records in the Digest Records File.

“For example, exhibits may be associated with any record in the Digest Records File, so that the system may track exhibits across multiple transcripts” (column 14, lines 55-68).

“A user would typically enter exhibits and topics...the user may associate topics and exhibits with records in the Digest Records File...The user may enter (batch) all or a portion of the exhibits for that transcript (column 15, lines 27-50). Therefore, a reasonable interpretation for the disclosure is that the user input associates exhibits and transcripts.

### **PRIOR ART**

11. In regard to claim 1, Robins discloses a method for managing electronic transcripts and electronic exhibits performed on at least one processor (Abstract etc.), the method comprising the steps of:

Art Unit: 2168

Selecting an electronic transcript file to associate with at least one electronic exhibit

(Figure 11, Items 132, and 137, “For selected item”);

Displaying the association tool (Figures 11-21, the user interface has been interpreted as “the association tool”);

Inputting a user defined association between the electronic transcript and the electronic exhibit (column 15, lines 27-50, especially, “A user would typically enter exhibits and topics...the user may associate topics and exhibits with records in the Digest Records

File...The user may enter (batch) all or a portion of the exhibits for that transcript);

Identifying at least one electronic exhibit to be associated with the electronic transcript by the user defined association (column 15, lines 27-50, especially, “A user would typically enter exhibits...selecting an exhibit set”);

Choosing a type of association between the electronic transcript and the at least one electronic exhibit (column 15, lines 27-50, especially, “A user would typically enter...topics...the user may associate topics and exhibits with records [transcripts] in the Digest Records File”); and applying the association to the electronic transcript such that the electronic transcript and the at least one electronic exhibit are associated (column 20, lines 35-45, especially, “one-to-one association...one-to-many association...”

12. In regard to claim 2, Robins discloses the type of association is a link from the electronic transcript to the at least one electronic exhibit (Abstract, 9-13, and column 3, lines 7-11).

13. In regard to claim 3, Robins discloses activating the applied association (column 16, lines 17-19, “make exhibit associations”); and displaying (Figure 13, “Display” button) the at least one electronic exhibit (Figure 14 and 17, in their entirety).

Art Unit: 2168

14. In regard to claim 4, Robins discloses displaying the electronic transcript in a first window (Figure 16, Item 174); and displaying the at least one electronic exhibit in at least a second window (Figure 16 in its entirety).
15. In regard to claim 13, Robins discloses recognizing the characters of the at least one electronic exhibit to provide character searching of the at least one electronic exhibit (column 14, lines 23-53).
16. In regard to claim 14, Robins discloses importing a file to a project, the file consisting of transcript files (column 13, lines 54-61).
17. In regard to claims 15, 16, 21, 22, and 24, Robins discloses, in addition to the disclosures cited above, the transcript manager, an organization and control module (column 14, line 55, to column 16, line 6), memory (column 5, lines 36-30), and display (Figures 11-21).
18. In regard to claims 19 and 20, Robins discloses "floppy disk of the transcript" (column 13, line 57).

#### **Claim Rejections - 35 USC § 103**

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

Art Unit: 2168

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 5-12, 17, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robins (US 5392428 A) as applied to claims 1-4, 13-16, 19-22, and 24 above, and further in view of Przekop et al. (20030078973 A1) (Przekop hereafter).

#### **MOTIVATION TO COMBINE**

22. Przekop describes an improvement for dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions (page 2, column 2, [0021]).

While, Robins as cited above describe a method for managing and analyzing documents related to depositions (Abstract etc., column 1, lines 25-35). Therefore, one of ordinary skill in the art at the time of the invention would have been motivated by Przekop to improve the method of Robins to dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions.

#### **PRIOR ART**

23. In regard to claims 5-8 and 23, Robins describes all the limitations of said claims except for the limitation of “audio file” and “video file”. Przekop describes a novel software that synchronizes transcript and video/audio record (page 2, [0012]). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Robins that synchronizes transcript and video/audio record as

described by Przekop to dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions.

24. In regard to claims 9 and 11, Robins describes all the limitations of said claims except for the limitation of “synchronizing” and “appending the media file”. Przekop describes a novel software that synchronizes transcript and video/audio record (page 2, [0012]) and appending the media file (page 2, column 2, and page 4, [0037]-[0040]). The disclosure of synchronizing the transcript with the video/audio record has been interpreted as “advancing...along.” Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Robins that synchronizes transcript and appending the video/audio record as described by Przekop to dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions.

25. In regard to claim 10, Robins describes all the limitations of said claims except for the limitation of “synchronizing” and “appending the media file”. Przekop describes a novel software that synchronizes transcript and video/audio record (page 2, [0012]) and appending the media file (page 2, column 2, and page 4, [0037]-[0040]). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Robins that synchronizes transcript and appending the video/audio record as described by Przekop to dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions.

26. In light of the vague and indefinite issue directed to claim 12, said claim is rendered obvious over the cited prior art.



27. In regard to claims 17 and 18, Robins describes all the limitations of said claims except for the limitation of "a network connection". Przekop describes a network via broadband connection or wireless connection (page 3, column 2, [0032]). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Robins that synchronizes transcript and appending the video/audio record as described by Przekop to dramatically reducing the expense and delays of collaborating on legal proceedings, such as depositions.

### **CONCLUSION**

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2002/0124018 A1.

29. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables

Art Unit: 2168


applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

30. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly   
Patent Examiner  
10/29/06